

**REMARKS/ARGUMENTS**

Claims 1-10, 16-19, 20 and 21 stand rejected as obvious over the '714 patent and for obviousness-type double patenting over the claims of this patent. In the previous response it was pointed out that the alloys of the current invention have laths of martensite alternating with thin films of austenite whereas those of the '714 patent had a microstructure consisting of a ferrite matrix and a dispersed second phase such as martensite, bainite and/or austenite.

In the current rejection the Examiner commented that the claims did not exclude ferrite so that the rejection was valid. The Examiner suggested amending the claims to call for a microstructure "consisting of" laths of martensite alternating with films of from about 0.50 to about 15% by volume of retained austenite.

In this Amendment, Applicants have amended claim 1 to require a microstructure consisting essentially of such components. The phrase "consisting essentially of" has been used, as Applicants should not be required to exclude some minor amounts of ferrite that may be present in a product, for instance incidentally, but that do not affect the significant properties of the alloy whereas ferrite is an essential and necessary component of the microstructure of the alloys of the '714 patent. Claim 16 has been canceled. Applicants submit that this amendment clearly distinguishes the claimed process from the process and materials of the '714 patent, both as to obviousness under 35 U.S.C. 103 and as to obviousness-type double patenting, and respectfully request withdrawal of these rejections.

Claims 1-15, 20 and 21 stand rejected as obvious over the '968 patent and for obviousness-based double patenting over its claims. These rejections are respectfully traversed.

As stated previously, the '968 patent discloses only conventional means of performing cold working, and does not disclose any means wherein the cold working is carried out without heat treatment between stages. The examiner responded that at col. 6 lines 1-7 this patent teaches that cold working techniques may be used to produce the products described therein, and asserts that the text does not suggest that the alloys are produced by conventional cold working with intermediate patenting.

Applicants submit that, to the contrary, in the absence of any statement that any special techniques should be used, this paragraph cannot be read to contain any suggestion of using any techniques *other than* conventional techniques for the further processing of the disclosed alloys. The '968 patent is directed to a means for avoiding autotempering in the production of the alloy through controlling the cooling rate, as stated in claim 1 of that patent, and other aspects of processing the alloys are conventional, and not part of the invention. The '968 patent does not render obvious the presently claimed process wherein first a carbon steel alloy is formed that has a microstructure consisting essentially of laths of martensite alternating with from about 0.5% to about 15% by volume of films of retained austenite, and (b) then the carbon steel alloy is cold worked to a reduction sufficient to achieve a tensile strength of at least about 150 ksi. As for double patenting, the claims of this application lack an essential step of the process of the '968 claims. They do not include any steps of controlling the cooling rate or means of avoiding autotempering, and thus are not obvious variations of the '968 claims.

Applicants respectfully request withdrawal of both rejections of the current claims over the '968 patent.

### CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,

Joel G. Ackerman  
Reg. No. 24,307

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 415-576-0200  
Fax: 415-576-0300  
JA:ja  
60683196 v1